

This Opinion is not a
Precedent of the TTAB

Mailed: February 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Bernatello's Pizza, Inc.

v.

Timothy Bammann

—
Opposition No. 91251606
—

Anthony J. Bourget of Bourget Law SC for Bernatello's Pizza, Inc.

Anderson J. Duff of Duff Law PLLC for Timothy Bammann.

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Before Lykos, Goodman and English,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Timothy Bammann ("Applicant") filed an application to register the mark ROMA PIZZA (standard characters) for "Restaurant services; Restaurant services, namely,

providing of food and beverages for consumption on and off the premises; Take-out restaurant services” in International Class 43.¹

Bernatello’s Pizza, Inc. (“Opposer”) opposes registration of Applicant’s ROMA PIZZA mark on the grounds of likelihood of confusion under Section 2(d) and nonuse in commerce as of the application filing date. Opposer has pleaded ownership of the following registered marks:² ROMA (standard characters) for “frozen pizza” in

International Class 30³;  for “frozen pizza” in International Class 30⁴; and REACH FOR A ROMA! (standard characters) for “pizza,” in International Class 30.⁵ Notice of Opposition ¶ 3, 1 TTABVUE. Opposer also alleges prior common law rights in the ROMA mark since 1963. Notice of Opposition ¶ 3, 1 TTABVUE.

¹ Application Serial No. 87753376 was filed on January 12, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use and first use in commerce of January 1, 1977. The application includes a statement that the English translation of “ROMA” in the mark is “GYPSY.” The word “PIZZA” in the mark has been disclaimed.

References to the briefs and the record refer to the Board’s TTABVUE docket system.

² Opposer provided copies of TSDR (trademark document and status retrieval) printouts of its pleaded registration as exhibits to the notice of opposition, thereby properly making them of record. 1 TTABVUE. *See* Trademark Rule 2.122(d)(1).

³ Registration No. 3839799 issued August 31, 2010; renewed.

⁴ Registration No. 2315169 issued February 8, 2000; renewed. The registration includes a statement that the English translation of “Roma” is Rome.

⁵ Registration No. 3817787 issued July 13, 2010; renewed.

Applicant filed an answer denying the salient allegations in the notice of opposition and pleading the affirmative defense of failure to state a claim as well as two defenses that are amplifications of his denial of likelihood of confusion.⁶

Each party filed a trial brief and Opposer filed a reply brief.⁷

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved application. In addition, Opposer introduced a notice of reliance upon third-party registrations from the Office's TESS (trademark electronic search system) database, Internet evidence on third-party websites, a map from the Internet to demonstrate that Bangor, Michigan is located more than 300 miles from St. Ignace, Michigan, and the declaration testimony of Chad D. Schultz, Chief Operating Officer of Opposer. 13 TTABVUE. Opposer introduced a second notice of reliance on Applicant's interrogatory responses and responses to document requests. 16 TTABVUE.

Applicant introduced a notice of reliance upon third-party registrations from TSDR; Applicant's application from TSDR; assignment record from the Office's Assignment Branch for a third-party registration; TSDR printout of Pizza Dave and design registration owned by Opposer; third-party Facebook page; third-party Internet website printouts; motion to consent to a post-publication amendment in a

⁶ 4 TTABVUE. The failure to state a claim defense has been waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.).

⁷ Opposer's brief is at 17 TTABVUE and its reply brief is at 19 TTABVUE; Applicant's brief is at 18 TTABVUE.

Board proceeding involving Opposer and a third party (Opposition No. 91222369); July 17, 2018 notarized affidavit signed by Timothy Bammann filed in a court proceeding involving Mr. Bammann and a third party; April 22, 2020 Declaration of Timothy Bammann; April 23, 2020 Declaration of Anderson J. Duff, counsel of Applicant; May 17, 2021 declaration of Timothy Bammann introducing confidential documents relating to Applicant's business, including assignment to Applicant; documents filed in a court proceeding involving Opposer and a third-party that include the declaration of Chad D. Schultz. 14 TTABVUE. Confidential exhibits from the May 17, 2021 Bammann declaration are at 15 TTABVUE.

II. Evidentiary Objection and Stipulated Testimony

A. Evidentiary objection

Opposer has objected on the basis of relevancy, admissibility and materiality to exhibits E&F of Applicant's notice of reliance which are 1) a memorandum in support of preliminary injunction, involving Opposer and a third-party, and 2) the declaration of Chad D. Schultz that accompanied the memorandum and motion. Petitioner's brief 17 TTABVUE 28-29. These documents were provided by Applicant "to show how Opposer has characterized the goods it provides" Applicant's notice of reliance 14 TTABVUE 3, ¶¶ 5-6. Opposer argues that "this testimony was not taken in connection with this Opposition and does not relate to Opposer's ROMA Marks or Applicant's ROMA mark. Thus, it has absolutely no bearing on the issues in this Opposition." Petitioner's brief 17 TTABVUE 29.

In response, Applicant argues that the Board can consider certain prior statements of Opposer about the goods and services in the filings. 18 TTABVUE 26. Applicant highlighted portions of the statements that he offers for the Board's consideration.

The highlighted portions that Applicant references are as follows:

Chad D. Schultz affidavit:

Bernatello's manufactures frozen pizzas under its own brands including: BREW PUB, BELLATORIA, ORV'S, and ROMA. These brands target different consumer groups within the frozen pizza marketplace by nature of their price point, quality and quantity of ingredients, and packaging.

At least as early as 2012, I and others at Bernatello's felt that consumers believed frozen pizzas were inferior to restaurant or freshly-made pizzas. This was confirmed later by the Mintel Report noted below.

As stated by the Mintel Report (a widely recognized market report on the pizza industry), . . . A majority of consumers feel that store bought pizza is not as good as restaurant pizza, which means store-bought brands must do more to bring their product quality closer to that of restaurants to compete with pizzeria.

As a frozen pizza manufacturer and distributor in the Midwest region, Bernatello's directly competes with other frozen pizza manufacturers and distributors in Wisconsin, Minnesota, Iowa, North Dakota, South Dakota, and Michigan.

14. The following is a table of the Frozen Pizza Category Segments with representative examples of brands and price ranges:

Segment	Average Retail	Bernatello's Pizza, Inc. Brands	Competitive Brands
Price/Value	Less Than \$2.00	Roma	Palermo's Classics, Totino's, Tony's
Value	\$2.00-\$3.00	Orv's Tasty Toppings	Jacks
Main Stream	\$3.00-\$5.00	Orv's Rizers	Tombstone, Palermo Primo, Red Baron
Premium	\$5.00-\$6.00	Bellatoria/Connie's Naturals (Partner Brand)	DiGiorno, California Pizza Kitchen, Freshchetta
Super Premium	\$6.00 +	BREW PUB Lotzza Motzza	Pizza Corner-North Dakota, Heggie's-Minnesota, Screamin' Sicilian

Memorandum in support of preliminary injunction:

Bernatello's distributes its frozen pizza varieties to various grocery and convenience stores throughout the Midwest region, including Wisconsin, Minnesota, Iowa, North Dakota, South Dakota, and Michigan. (PFOF ¶ 7.)

Evidence of prior inconsistent statements may be relevant, material, and admissible evidence in Board proceedings. For example, in *Cumberland Packing Corp. v. McMahan Prod., Inc.* 189 USPQ 428, 429 (TTAB 1975) (citing *Bakers Franchise Corporation v. Royal Crown Cola Co.*, 404 F.2d 905, 160 USPQ 192 (CCPA, 1969) (verified notice of opposition involving applicant and third party was admissible evidence of prior inconsistent statement)), the Board allowed evidence of a prior inconsistent statement stating "[n]o reason has been suggested why the same approach [taken in *Bakers Franchise*] ought not to be taken in this case, particularly since the prior statement proffered in evidence by applicant was made under oath by an apparently authorized agent of opposer under circumstances which opposer's counsel in the earlier case was satisfied were sufficiently trustworthy to warrant a

stipulation that the discovery testimony be admitted in evidence. We therefore admit and consider the testimony quoted above for all relevant and material purposes. *See* Rule 801(d)(2)(C), Federal Rules of Evidence; 4 Weinstein’s Evidence, paragraphs 801(d)(2) [01], 801(d)(2)(C) [01] (1975).” *See also* Fed. R. Evid. 607, 613(b) and 801(d)(2).

Therefore, we overrule this objection because testimony related to marketing and distribution channels, competition, and consumer perception is relevant to the likelihood of confusion analysis. We consider the highlighted portions to the extent they are prior inconsistent statements.⁸

B. Stipulated declarations

As indicated in the description of the record, Applicant filed declarations dated April 22, and April 23, 2020 submitted in connection with his cross-motion and response to summary judgment. Although the parties did not stipulate to their submission, Opposer has not objected to them and has treated them of record, by referencing the testimony or exhibits provided by them. Therefore, we treat these declarations as being stipulated into the record. *See Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423, 1425 n. 8 (TTAB 1993) (objection waived where although there was no such agreement, plaintiff did not object to declarations with exhibits submitted by defendant and treated the evidence as if properly of record).

⁸ Pleadings and motions filed in another proceeding may be considered for evidentiary admissions against interest. *Maremont Corp. v. Air Lift Co.*, 463 F.2d 1114, 174 USPQ 395, 396 (CCPA 1972).

Applicant also submitted a 2018 affidavit submitted in a state court action involving Applicant and a third party (exhibit NN of Applicant's notice of reliance). Applicant's notice of reliance 14 TTABVUE 300-304.

As this affidavit does not meet the criteria of Trademark Rule 2.122(f), 37 C.F.R. § 2.122(f), we do not consider it. *Aloe Creme Lab's, Inc. v. Helene Curtis Indus., Inc.*, 171 USPQ 170, 171 n.4 (TTAB 1971) ("While applicant has submitted for the record testimony from another proceeding involving opposer and a different party and the file history of a prior opposition involving opposer and a third party, this material is not germane to the issue herein ...").

III. Statutory Entitlement to Bring an Opposition

In every inter partes case, the plaintiff must establish its statutory entitlement to bring an opposition or cancellation proceeding. To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020) *cert. denied sub. nom.*, 141 S. Ct. 2671 (2021). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at 7-8.

Opposer submitted, with its notice of opposition, copies of its pleaded registrations from the USPTO electronic database showing their status and title. Trademark Rule 2.122(d)(1), 37 C.F.R. §§ 2.122(d)(1). The pleaded registrations establish Opposer's

direct commercial interest in the proceeding; this direct commercial interest establishes a reasonable belief in damage. *See Herbko Int'l v. Kappa Books*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) (“In most settings, a direct commercial interest satisfies the ‘real interest’ test”); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ...direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest).

Therefore, Opposer has demonstrated an interest falling within the zone of interests protected by the statute and a reasonable basis for its belief of damage proximately caused by registration of the mark to show entitlement to a statutory cause of action. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) *cert. denied*, 142 S. Ct. 211 (2021); *Cunningham*, 55 USPQ2d at 1844.

IV. Non-use in Commerce Claim

“Under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), a mark may not be registered unless it is ‘used in commerce,’ and ‘an applicant may not claim a Section 1(a) filing basis unless the mark was in use in commerce on or in connection with all the goods or services covered by the Section 1(a) basis as of the application filing date.’” *Mars Generation, Inc. v. Albert G. Carson IV*, 2021 USPQ2d 1057, at *8 (TTAB 2021) (citing *Hachette Filipacchi Presse v. Elle Belle LLC*, 85 USPQ2d 1090, 1093 (TTAB 2007) (citing Trademark Rule 2.34(a)(1)(i), 37 C.F.R. § 2.34(a)(1)(i)).

The Trademark Act provides that “[t]he term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127; *see also Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1642 (Fed. Cir. 2016) (providing an overview of the statutory use in commerce requirement).

Opposer submits that “Applicant’s alleged operation of a single restaurant location at 111 West Monroe St., Bangor, Michigan is insufficient to establish use of its mark in commerce.” Opposer’s brief 17 TTABVUE 14. In support, Opposer references the declaration testimony of Timothy Bammann where he stated “I am the current owner and operator of the restaurant located at 111 West Monroe St., Bangor, Michigan 49013.” Opposer’s Brief, 17 TTABVUE 14 (referencing May 17, 2021 and April 22, 2020 Bammann declarations, 14 TTABVUE 41 and 299 (Exhibits C and MM)).

In response, Applicant argues that “[n]owhere in the record does Applicant state that it has not provided the services identified in the subject application to out-of-state customers.” Applicant’s brief 18 TTABVUE 7. Applicant submits that “[i]t is inconceivable that a restaurant operating since 1978 has not served out of state customers. Rendering services in this manner is enough, as a matter of law, to meet the ‘use in commerce’ requirement.” Applicant’s brief 18 TTABVUE 7.

We find that the testimony referenced by Opposer is insufficient to meet Opposer’s burden for its non-use in commerce claim because Applicant did not need to make a particularized showing that his services were offered to out of state residents nor did

he need to present evidence of an actual and specific effect that the rendering of his restaurant services had on interstate commerce. *Christian Faith Fellowship Church*, 120 USPQ2d 933.

The Trademark Act extends to all commerce which Congress may regulate. *Christian Faith Fellowship Church* 120 USPQ2d at 1646 (citing *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292, 1295 (Fed. Cir. 1991)). The economic activity must not be viewed in isolation but in the aggregate. *Christian Faith Fellowship Church*, 120 USPQ2d at 1643-46 (discussing United States Supreme Court contemporary commerce clauses decisions). Thus, contrary to Opposer's arguments, it is not determinative that Applicant admittedly only offers restaurant services in one location in Michigan as it is not necessary that the restaurant "services be rendered in more than one state to satisfy the use in commerce requirement." *Larry Harmon Pictures Corp.*, 18 USPQ2d at 1295. "[P]roof that the Applicant's conduct in and of itself affected or threatened commerce is not needed. All that is needed is proof that the Applicant's conduct fell within a category of conduct that, in the aggregate, had the requisite effect." *Christian Faith Fellowship Church*, 120 USPQ2d at 1646-47 (quoting *Taylor v. United States*, ___ U.S. ___, 136 S.Ct. 2074, 2080-81 (2016)).

It has been previously held that restaurant services offered in one location in intrastate commerce constitutes use in interstate commerce. *Larry Harmon Pictures Corp.*, 18 USPQ2d at 1295. Therefore, Opposer has not established that Applicant's rendering of its restaurant services in Bangor, Michigan, in the aggregate, does not

have an effect on commerce that is regulable by Congress. *See Christian Faith Fellowship Church*, 120 USPQ2d at 1646-47 (citing *Wickard v. Filburn*, 317 U.S. 111, 125, (1942), (“even if . . . activity be local . . . it may still, whatever its nature, be reached by Congress if it exerts a substantial economic effect on interstate commerce”)).

Because Opposer has not met its burden, the opposition is dismissed as to the non-use in commerce claim.

V. Section 2(d) Claim

A. Priority

Because Opposer has made its valid and subsisting pleaded registrations of record, and Applicants have not counterclaimed to cancel any of them, priority is not an issue in this case as to the pleaded marks for the goods recited in those registrations. *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

B. Likelihood of Confusion

We now turn our attention to the likelihood of confusion analysis. We consider Opposer’s pleaded registered marks vis-à-vis the mark in the involved application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014). We focus our likelihood of confusion analysis on Opposer’s standard character ROMA mark (Registration No. 3839799) for “frozen pizza.” If we do not find a likelihood of confusion with this registered mark and its goods, then there would be no likelihood of confusion with the marks in the other registrations.

See New Era Cap Co., Inc. v. Pro Era, LLC, 2020 USPQ2d 10596, at *9-10 (TTAB 2020).

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence.

1. Similarity of the Goods and Services

We first consider the *DuPont* factor regarding the similarity or dissimilarity of the parties' respective goods and services.

We must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the respective goods and services emanate from the same source. *See Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Although Applicant seeks registration for restaurant services and Opposer offers frozen pizza “there is no per se rule which mandates a finding that confusion is likely whenever foods and restaurant services are sold under similar marks.” *In re Azteca Rest. Enter. Inc.*, 50 USPQ2d 1209, 1210 (TTAB 1999). Rather, “[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services.” *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982). Thus, for purposes of our analysis regarding the relatedness of the involved restaurant services and

frozen pizza, we look for evidence showing “something more” to a relationship other than the obvious food aspect.

The “something more” requirement has been found to exist where the food products are the same type of food offered in the restaurant. *See, e.g., In re Azteca Rest.*, 50 USPQ2d at 1211 (“something more” was found because “Mexican food items are often principal items of entrees served by restaurants, certainly by Mexican restaurants. The average consumer, therefore, would be likely to view Mexican food items and Mexican restaurant services as emanating from or sponsored by the same source if such goods and services are sold under the same or substantially similar marks”); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074, 1075 (TTAB 1990) (“Applicant’s mark makes it clear that its restaurant serves pancakes and, no doubt, pancake (or table) syrup, as well. There is an undeniable connection between the goods of the registrant and the services of applicant.”).

Opposer submitted TESS copies of use-based third-party registrations showing the same marks registered in connection with both restaurant services and frozen pizza to show “pizza goods are highly related to pizza restaurant services.”⁹ Opposer’s

⁹ Some of the registrations submitted by Opposer are cancelled and have no probative value as they only constitute evidence that the registration issued. *See, e.g., Sunnen Products Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). Some of the third-party registrations submitted by Opposer are in the nature of house marks that include a wide variety of goods and services and are of little probative value in showing that the goods and services are related. *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1998) (Board discounted the probative value of two registrations for a large department store and an amusement park, where a wide variety of goods and services are sold). Some of the registrations are for a different mark owned by the same entity. Opposer also submitted third-party applications to show that the goods and services are related. However, applications are only evidence that the applications have been filed and are not evidence of use. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1089 (TTAB 2016).

first notice of reliance, 13 TTABVUE 2. Applicant criticizes this evidence arguing that only a “handful” of the use-based third-party registrations list restaurant services and pizza and only twenty-five of the fifty-nine third-party registrations are relevant. Applicant’s brief 18 TTABVUE 13. Applicant also points out that some of these registrations are cancelled or are owned by the same party and that the Pizza Dave and design registration is owned by Opposer.¹⁰ Applicant’s brief 18 TTABVUE 13, 16.

Opposer submits that “[t]he few discrepancies in Opposer’s evidence as noted by Applicant do not erase the volume of evidence demonstrating” the “highly related nature of the goods and services.”¹¹ Opposer’s reply brief 19 TTABVUE 9.

Applicant also argues that Opposer’s evidence reflects a very small percentage (6 percent, according to Applicant) of restaurants that also offer frozen pizza and should not be entitled to great weight. Applicant’s brief 18 TTABVUE 17-18. To support this argument, Applicant points to its TESS search results for live registrations for “restaurant,” “pizza,” and “frozen” that yields only 73 results, with many not listing “frozen pizza” but other frozen goods. Applicant’s brief 18 TTABVUE 17. Applicant’s

¹⁰ Applicant also points to submitted website and Facebook evidence that he believes shows that two of the cited marks are not offering frozen pizza, and that one of the registrants might not be in business. Applicant’s brief 18 TTABVUE 16. However, even if that is the case, we cannot conclude that Applicant’s evidence diminishes the probative value of Opposer’s third-party registration evidence that does not have the deficiencies listed in n.9.

¹¹ Opposer also references a decision in an ex parte case where Opposer was the registrant and a decision in an inter partes case involving Opposer and a third party, both finding frozen pizza and restaurant services related. Opposer’s brief 17 TTABVUE 19. However, each case is decided on its own facts and record and those decisions do not inform our decision here. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

notice of reliance, 14 TTABVUE 143-144. Applicant did not submit any representative registrations to accompany this evidence.

Applicant also points to a live registration TESS search for “restaurant services” that “returns fifty-six thousand seven hundred forty-four (56,744)” results while a live registration TESS search for restaurants that also include the word “pizza” or variations thereof such as “pizzeria” returns “one thousand two hundred forty-eight (1,248) results.” Applicant’s brief 18 TTABVUE 17; Applicant’s notice of reliance, 14 TTABVUE 162-163, 165-166.

A mere list of live registrations is of little or no probative value. *See Nat’l Fidelity Life Ins. v. Nat’l Ins. Trust*, 199 USPQ 691, 694 n.5 (TTAB 1978) (list of registrations without goods and services and other relevant information “has no probative value.”). *See also Black & Decker Corp. v. Emerson Elec. Co.*, 84 USPQ2d 1482, 14894 (TTAB 2007) (“Submitting lists of third-party registrations . . . is not an acceptable way to make such registrations . . . of record.”). The mere fact, based on the results of these TESS searches, that other third parties do not offer both types of goods and services, or only a small percentage offer both, or that there are only a small number of restaurants that list they are serving pizza does not undercut the probative value of third-party registrations or the website evidence that shows some parties do offer both goods and services under the same mark. *In re G.B.I. Tile and Stone Inc.*, 92 USPQ2d 1366, 1370 (TTAB 2009). There is no requirement for goods or services to be found related based on third-party registration evidence that all or even a majority of the sources of one type of goods or service must also be sources of the other type of

goods or services. *Id.* Therefore, evidence showing only that the source of one product may not be the source of another product does not aid Applicant in its attempt to rebut this evidence. Additionally, the fact that only a small number of registrants list “pizza” or “pizzeria” in their identification does not necessarily establish that these registrant’s do not offer pizza; the Office does not require registrants to list the type of food offered when identifying their services as “restaurant services.”

“Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.” *See In re Mucky Duck Mustard Co.*, 6 USPQ2d at 1470 n.6. *See also Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (“The use based, third-party registrations . . . also have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.”). Even with Applicant’s criticisms, we find there are a sufficient number of third-party registrations that make this evidence probative. *See, e.g., In re Azteca Rest.*, 50 USPQ2d at 1211 (10 registrations probative that the goods and services emanate from the same source).

Opposer also introduced Internet website evidence showing 28 third parties using the same marks for restaurant services (chain restaurants, multiple location restaurants in the same geographic region, and single location restaurants) and

frozen pizzas offered through retail sales. Opposer submitted these uses to show relatedness “because pizza restaurants regularly provide frozen varieties of pizzas and frozen pizza manufacturers also establish restaurants.” Opposer’s first notice of reliance, 13 TTABVUE 7.

These uses include: California Pizza Kitchen restaurant offering frozen pizza (retail sale), Gino’s East of Chicago restaurant offering frozen pizza (retail sale-Walmart), Uno Pizzeria and Grill restaurant, offering frozen pizza (retail sale), Davis Bros. Pizza restaurant offering pizza (“frozen pizza locator”), Shakespeare Pizza restaurant offering frozen pizza (“where to buy”), Table 87 Coal Oven Pizza restaurant offering frozen pizza (“where to buy”), Mystic Pizza restaurant offering frozen pizzas (retail sale).¹²

Applicant argues that this “common law evidence is even less convincing.” Applicant’s brief 18 TTABVUE 18. Applicant also argues that the Internet evidence is hearsay. Applicant’s brief 18 TTABVUE 12. However, even if the Internet evidence is hearsay because the contents cannot be corroborated by a competent witness, they “are frequently competent to show, on their face, matters relevant to trademark claims (such as public perception), regardless of whether the statements are true or false.” *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1427-28 (TTAB 2014). Therefore, these web pages show that the public has been exposed to pizza restaurants offering frozen pizza either for retail sale under the same mark.

¹² Some of these uses reflect use of the third-party registered marks submitted by Opposer e.g., California Pizza Kitchen, Roberta’s, Home Run Inn, and Green Mill.

Cf. In re Davey Prods. Pty Ltd., 92 USPQ2d 1198, 1203 (TTAB 2009) (Internet evidence may be relevant to show relatedness of goods in a likelihood of confusion determination).

Applicant also argues that “there is no question that Applicant does not sell the Opposer’s frozen pizzas in its restaurant” and that “[e]ven if the evidence cited by Opposer demonstrated that the respective registrants provide both restaurant services and food, it does not show that frozen pizzas are sold at the relevant restaurants as was the case in *In re Opus One*. . . . Consumers are not used to the sale of frozen pizza at a restaurant.” Applicant’s brief 18 TTABVUE 12, 14. However, our cases have found “something more” can be found when a restaurant serves the product in the restaurant. *In re Giovanni Food Co., Inc., In Re Giovanni Food Co., Inc.*, 97 USPQ2d 1990, 1992 (TTAB 2011) (“We observe that the Board has found the ‘something more’ requirement to be met where Applicant’s mark made clear that its restaurant specialized in registrant’s type of goods”); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001) (“The fact that Applicant’s restaurant serves the type of goods (indeed the actual goods) identified in the cited registration is certainly probative evidence which supports a finding under the second *du Pont* factor that Applicant’s services and [registrant’s] goods are related”). Additionally, as Opposer points out, the question is not whether Applicant provides frozen pizza, but whether purchasers would perceive goods such as frozen pizza and restaurant services emanating from the same source under similar marks.

In this case the evidence reveals an “undeniable connection” between the pizza which Opposer offers in frozen form and the pizzas offered fresh in Applicant’s restaurant. Applicant’s ROMA PIZZA mark includes the word “pizza,” which describes a type of food served in Applicant’s restaurants and the type of frozen food offered by Opposer. Applicant has submitted evidence showing that pizza is a common menu item, especially in Italian-style restaurants. Applicant’s notice of reliance, 14 TTABVUE 247-269, 294-297. Applicant’s identification for “restaurant services” and “take-out restaurant services” is broad enough to encompass restaurants offering pizzas or even a pizzeria restaurant.

Additionally, the marketplace evidence submitted by Opposer demonstrates that consumers encounter frozen pizza sold or distributed through non-restaurant channels, particularly grocery stores and supermarkets under the same mark as restaurants that offer pizza.¹³ The evidence suggests that pizza restaurants, in particular, venture into the frozen pizza industry, marketing frozen pizza under their restaurant marks.

Here we find that Opposer has demonstrated the requisite “something more.” Pizza is a common menu item in restaurants, and frozen pizza is a common offering by restaurants at retail locations such as grocery stores and supermarkets. Applicant’s restaurant name includes PIZZA, and its services are broadly described

¹³ Evidence in the record shows that some pizza restaurants offer their pizza for online purchase. However, it is unclear from the record if online pizza is delivered in refrigerated or in frozen form.

to include the offering of pizza. Overall, we find that the record supports the relatedness of restaurant services and frozen pizza.

This *DuPont* factor weighs in favor of a finding of likelihood of confusion.

2. Channels of Trade

This *DuPont* factor must be assessed according to the identifications of the respective goods and services in the pleaded registration and application, not on extrinsic evidence of actual use. *Octocom Sys., Inc. v. Houston Comps. Serv., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In the absence of specific limitations in the application and registration, we consider “the normal and usual channels of trade and methods of distribution” for these goods and services. *CBS Inc. v. Morrow*, 708 F.2d 1579218 USPQ 198, 199 (Fed. Cir. 1983) (citing *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed.Cir.1983)).

Opposer’s witness testified generally about its business of producing and selling pizza under various brand names. Schultz declaration ¶¶ 4-5, 13 TTABVUE 231-232. Mr. Schultz testified specifically that its ROMA pizza products are sold in supermarkets in Wisconsin, Minnesota, Iowa, Nebraska, U.P. of Michigan, Illinois, North Dakota, South Dakota, Missouri, West Virginia, Indiana, Oregon, Idaho, Texas, California, North Carolina, South Carolina, Tennessee, Kentucky, Colorado, Arizona, Kansas, Montana, Maryland, Ohio, and Wyoming. Schultz declaration ¶ 10, 13 TTABVUE 232. Opposer recently started selling its Roma pizza products at Menards supermarket in Michigan. Schultz declaration ¶ 11, 13 TTABVUE 232.

Applicant argues that “[t]he circumstances under which consumers encounter and purchase freshly made pizza could not be any more different” and that the restaurant

experience in ordering and eating pizza is different from the grocery store experience of purchasing pizza for the home. Applicant's brief 18 TTABVUE 18.

We find the channels of trade for frozen pizza sold in retail stores such as grocery stores and supermarkets differs from the channels of trade for restaurant services.

This *DuPont* factor weighs against a finding of likelihood of confusion.

3. Conditions of Sale

The fourth *DuPont* factor considers the "conditions under which and buyers to whom sales are made." *DuPont*, 177 USPQ at 567. The applicable standard of care for the likelihood of confusion analysis is that of the least sophisticated consumer. *Stone Lion Capital Partners*, 110 USPQ2d at 1163. Given their nature, the goods and services would be marketed to general consumers who eat pizza and eat out at restaurants, including those offering pizza.

Opposer's witness testified that its "ROMA frozen pizzas are widely accessible and relatively inexpensive for consumers." Schultz declaration ¶ 17, 13 TTABVUE 234. Applicant's evidence shows third-parties offering restaurant pizza pies as a menu item ranging in price from \$7.95 to \$26.00, depending on size. Applicant's notice of reliance, 14 TTABVUE 174, 260-265, 276, 293, 297.

Frozen pizza is a relatively inexpensive item which would typically be purchased without a great deal of deliberation or care. Applicant's "restaurant services" are without any limitation as to cost or style of service and must be presumed to "encompass all services of the type identified." *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Therefore, Applicant's restaurant services must be presumed to encompass inexpensive or moderately-priced restaurant

services, including inexpensive pizza restaurants. “When goods [or services] are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such [goods or services] are held to a lesser standard of purchasing care.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

We find that the fourth *DuPont* factor weighs in favor of a finding of likelihood of confusion.

4. Strength of the Mark

We consider the extent of commercial strength or weakness in the marketplace under the fifth and sixth *DuPont* factors, “fame of the prior mark (sales, advertising, length of use)” and “the number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567. The fifth *DuPont* factor (fame) examines the extent to which the public perceives the mark as indicating a single source of origin. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 22 USPQ2d 1733, 1734 (Fed. Cir. 2017) (commercial strength is the extent to which the relevant public recognizes a mark as denoting a single source). Conversely, the sixth *DuPont* factor, (“the number and nature of similar marks in use on similar goods”) mitigates against a mark’s potential recognition by considering whether, because of widespread third-party use of similar marks in the marketplace, “customers have been educated to distinguish between different such marks on the bases of minute distinctions.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Additionally, in determining the strength of a mark, we consider inherent strength, based on the nature of the mark itself. *New Era Cap. Co. v. Pro Era LLC*, 2020 USPQ2d 10596, at *10; *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011). Word marks registered without a claim of acquired distinctiveness are “held to be inherently distinctive.” *See generally, Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000); (word marks that are arbitrary, fanciful, or suggestive are “held to be inherently distinctive.”); *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992) (suggestive, arbitrary and fanciful marks are deemed inherently distinctive). Nonetheless, we may find that a presumptively distinctive registered mark “is nevertheless weak as a source indicator” in the course of a *DuPont* analysis. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517-18 (TTAB 2016).

a. Fame

Opposer asserts that its ROMA marks “have strong consumer recognition based on their presence and success in the marketplace, entitling Opposer to a wide degree of protection from the confusingly similar ROMA PIZZA mark.” Opposer’s brief 17 TTABVUE 26. Opposer submitted the testimony of Chad D. Schultz to establish its commercial strength. Opposer’s notice of reliance, 13 TTABVUE 231-235.

The fifth *DuPont* factor (fame) examines the extent to which the public perceives the mark as indicating a single source of origin. *DuPont*, 177 USPQ at 567. A famous or commercially strong mark is one that has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed.

Cir. 2002); *Top Tobacco*, 101 USPQ2d at 1172 (fame or commercial strength is “based on the marketplace recognition value of the mark.”). “Fame of an opposer’s mark, if it exists, plays a ‘dominant role in the process of balancing the *DuPont* factors.’” *Recot, Inc. v. M.C. Becton*, 54 USPQ2d at 1897. Famous marks enjoy a “wide latitude of legal protection since they are more likely to be remembered and associated in the public mind than weaker marks.” *Palm Bay Imps.* 73 USPQ2d at 1694.

Fame, in the likelihood of confusion context, “varies along a spectrum from very strong to very weak.” *Joseph Phelps*, 22 USPQ2d at 1734. In view of the extreme deference that is accorded a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *North Face Apparel Corp. v. Sanyang Indus. Co. Ltd.*, 116 USPQ2d 1217, 1226 (TTAB 2015). It is important to note that fame for likelihood of confusion purposes and fame for dilution purposes are distinct concepts. *See Palm Bay Imps.*, 73 USPQ2d at 1692. Unlike dilution, fame for likelihood of confusion purposes does not require the opposer to show fame among every segment of the U.S. population. Rather, fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Id.* at 1694.

Fame or commercial strength for likelihood of confusion purposes may be measured indirectly by, for example, “the volume of sales and advertising expenditures of the goods sold under the mark” “and other factors such as length of

time of use of the mark; wide-spread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services.” *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

Opposer’s witness Mr. Schultz testified about the commercial strength of Opposer’s Roma marks and its unpleaded Roma for 1 marks for frozen pizza. Schultz declaration, 13 TTABUVE 231-234. Although it is unclear from Mr. Schultz’s testimony what markets Opposer’s predecessor was serving in 1964 when it began its initial offering of frozen pizza under the ROMA mark, Opposer now sells frozen pizza under the ROMA mark in supermarkets in 29 states. Schultz declaration ¶¶ 7, 10, 13 TTABVUE 232. Opposer offers eight frozen pizzas under the ROMA mark and four frozen pizzas under the unpleaded ROMA for 1 mark. Schultz declaration ¶ 8, 13 TTABVUE 232. Mr. Schultz listed Opposer’s advertising expenses from 2017 through 2020 (approximately \$2.3 million) which include “purchase of advertisements, event sponsorships, in-store promotions, and other marketing efforts,” shown below:

Advertising expenses

\$536,000 in 2017

\$552,000 in 2018

\$556,000 in 2019

\$688,000 in 2020

Schultz declaration ¶¶ 13-14, 13 TTABVUE 233.

Mr. Schultz also listed the quantity sold and sales (approximately \$81 million) for frozen pizzas sold under Opposer’s Roma and unpleaded Roma for 1 marks from 2015 through 2020 as follows:

Sales	Quantity
2015 \$11.2 M	2015 6.8 M
2016 \$11.9 M	2016 7.3 M
2017 \$13.4 M	2017 8.2 M
2018 \$13.8 M	2018 8.4 M
2019 \$13.9 M	2019 8.5 M
2020 \$17.2 M	2020 10.3 M

Schultz declaration ¶ 15, 13 TTABVUE 233.

Opposer’s witness’ testimony does not provide any context for the advertising and sales figures such as how these figures compare with other frozen pizza brands (e.g., where Opposer’s frozen pizza stands in terms of market share, how Opposer’s advertising expenditures relate to the expenditures of competitors, how many consumers encounter Opposer’s mark, etc.). *Bose*, 63 USPQ2d at 1309 (noting that a “tiny percentage of the market share for the product or a small share of advertising revenues for the product market could undermine the weight given to the figures for assessment of fame,” while “[l]arge market shares of product sales or large percentages of advertising expenditures in a product line would buttress claims to fame.”). Opposer also has not indicated what sales are attributed to the ROMA mark and what sales are attributed to the unpleaded ROMA for 1 mark.

Although the unit and frozen pizza sales are substantial, in comparison, the advertising figures are not large, and we have no context for assessing their effectiveness. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2009) (opposer’s advertising figures were “not particularly impressive” and “the problem that we have in assessing the effectiveness of the advertising expenditures is that there is no testimony or evidence regarding whether opposer’s advertising expenditures are large or small vis-à-vis other comparable medical products.”). There also is no evidence of the recognition of the mark such as press coverage, brand awareness studies, or the like.

We find that although the evidence reflects that Opposer’s ROMA mark has shown commercial success from sales, this evidence does not establish that its ROMA mark is widely recognized by a significant portion of the relevant consuming public. We find the evidence is not sufficient to show that Opposer’s ROMA mark is commercially strong to be dominant in the likelihood of confusion analysis.

We find the fifth *DuPont* factor neutral.

b. Conceptual strength and marketplace weakness

Evidence of the extensive registration and use of a term by others can be “powerful” evidence of weakness. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1475 (TTAB 2016) (“even where the record lacks proof of the

extent of third-party use, this evidence still may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak”). Third-party registration evidence goes to conceptual weakness, while evidence of their use and other third-party use goes to commercial weakness. *See Tao Licensing LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017).

Applicant argues that “the number of third parties using marks that incorporate ROMA for what may be related goods and services indicates that consumers have learned to distinguish between producers of frozen pizzas by looking at even minor differences between the marks at issue.” Applicant’s brief 18 TTABVUE 24.

Applicant provided third-party registration evidence for the term “Roma” in connection with food products and restaurant services and submitted evidence of their commercial use. *See Juice Generation*, 115 USPQ2d at 1671 (third-party registrations and uses “in the food service industry” which included food products and restaurant services are relevant to the question of weakness of a mark for restaurant services); *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *18 (TTAB 2020) (evidence that six local Brooklyn-formative named establishments use of the term “Brooklyn” in connection with beer sales have significant probative value in connection with strength of plaintiff’s BROOKLYN BREWERY and BROOKLYN marks for beer) *aff’d in part, rev’d in part, vacated in part*, 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021). Third-party registrations may be used in the manner of dictionary definitions “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive

meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation*, 115 USPQ2d at 1675.

Applicant submitted eleven third-party registrations, and for most, included evidence of their use:¹⁴

Four registrations owned by the same registrant:

- Reg. Nos. 1725523 and 2443653 for the mark  for food products including pizza for sale at wholesale to pizza parlors, restaurants and delicatessens for their in house preparation of meals;
- Reg. No. 2481136 for the mark  for food products including pizza for sale at wholesale to pizza parlors, restaurants and delicatessens for their in house preparation of meals; and
- Reg. No. 3486352 for the mark ROMA for pizza crust for food service use.

Applicant’s notice of reliance, 14 TTABVUE 176, 187, 197 and 206.

Applicant provided evidence of use of “Roma” by this Registrant in connection with pizza ingredients. The website evidence shows on its face that Registrant operates throughout the United States. Applicant’s notice of reliance, 14 TTABVUE 218.

- Reg. No. 2066993 for the mark AMORE ROMA for specialty gourmet pizza. Applicant’s notice of reliance, 14 TTABVUE 168.

Applicant provided evidence of use of the mark as a pizza menu item. Applicant’s notice of reliance, 14 TTABVUE 174.

¹⁴ Applicant also provided evidence of Reg. No. 4077841 Pizza Roma. Applicant’s notice of reliance, 14 TTABVUE 271. Although this registration has cancelled, and is only evidence that the registration issued, Applicant submitted evidence of use of Pizza Roma that we have considered. Applicant’s notice of reliance, 14 TTABVUE 276.



- Reg. No. 5232904 for the mark  for food including calzones, pasta, pasta sauce, flour-based gnocchi, spaghetti, spaghetti sauce. Applicant’s notice of reliance, 14 TTABVUE 284.

Applicant did not provide evidence of use for this registration.¹⁵ Applicant provided Wikipedia evidence that a calzone is “an oven-baked folded pizza that originated in Naples [Italy]” and an “efficient type of pizza for home delivery in Italy in the 1960s.” Applicant’s notice of reliance, 14 TTABVUE 290.

- Reg. No. 5474007 for the mark ROMA EXPRESS for restaurant services. Applicant’s notice of reliance, 14 TTABVUE 220.

Applicant provided evidence of use in San Diego, California. Applicant’s notice of reliance, 14 TTABVUE 243. The registrant explains on the web page that its “arancini, cannoli, and handcrafted Italian sodas” are based on Sicilian recipes. Applicant’s notice of reliance, 14 TTABVUE 243.

- Reg. No. 1318693 for the mark TONY ROMA’S for restaurant services. Applicant’s notice of reliance, 14 TTABVUE 224.

Applicant provided evidence of use and that the restaurant offers pizza, at a location in DuBuque, Iowa. Applicant’s notice of reliance, 14 TTABVUE 247.

- Reg. No. 1402555 for the mark CAFFE ROMA for restaurant services. Applicant’s notice of reliance, 14 TTABVUE 230.

Applicant provided evidence of use in North Beach, San Francisco, and the offering of pizza as a menu item. Applicant’s notice of reliance, 14 TTABVUE 250.

- Reg. No. 3805220 for the mark PASTA ROMA for restaurant services; Take-out restaurant services; Catering. Applicant’s notice of reliance, 14 TTABVUE 235.

Applicant provided evidence of use in Los Angeles, California as a quick service Italian restaurant “ristorante italiano,” that offers specialty pizzas. Applicant’s notice of reliance, 14 TTABVUE 257.

¹⁵ This third party was the defendant in Opposition No. 91222369 with Opposer as plaintiff. The parties’ settlement involved amending the identification of goods; “calzones” was allowed to remain. Applicant’s notice of reliance, 14 TTABVUE 279-281.

- Reg. No. 4804012 for the mark GO ROMA for restaurant and catering services. Applicant's notice of reliance, 14 TTABVUE 239.

Applicant provided evidence of use in Bollingbrook, Lincolnshire, and Northbrook IL and that the restaurant offers pizza. Applicant's notice of reliance, 14 TTABVUE 267.

A couple of the registrations indicate that the word "ROMA" as used in the mark is the English translation for "the city of Rome, Italy" and "Rome." Applicant's notice of reliance, 14 TTABVUE 186, 206. Opposer's pleaded ROMA and design registration also includes a statement that the English translation of "Roma" in its mark is "Rome." Notice of Opposition. In addition, Applicant's application file includes a dictionary submission by the Examining Attorney that "Roma" means Rome in English. May 1, 2018 Office Action at TSDR 5, collinsdictionary.com.

Applicant points out that most of the third-party registrations are two word marks that include a descriptive term, with the descriptive term disclaimed. Applicant's brief 18 TTABVUE 22. Applicant also argues that "several ... coexisted for decades and sold specialty pizzas in locations where the Opposer boasted a 'strong presence'" and "co-existed with other third-parties using ROMA or ROMA-formative trademarks for goods and services that may be related." Applicant's brief 18 TTABVUE 20, 22.

Opposer criticizes this evidence, and asserts that the marks "include multiple terms and/or design/styles" and are "different in some distinguishing respects" from Applicant's and Opposer's marks, asserting that "none of them use merely ROMA or ROMA pizza for restaurant services." Opposer's reply brief 19 TTABVUE 15.

We find the third-party registrations with translation statements corroborate the dictionary translation of “ROMA.” The eleven third-party registrations (seven with different owners) for ROMA or ROMA-formative marks show that various registrants and the USPTO relied on other distinctive matter (e.g., Amore Roma, Go Roma, designs) or descriptive matter (e.g., Caffè Roma, Pasta Roma, Roma Market, Roma Express) to distinguish the marks, although only some marks use ROMA as the lead term. *See also Jerrold Electronics Corp. v. The Magnavox Company*, 199 USPQ 751, 758 (TTAB 1978) (third-party registrations “reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can coexist provided that there is a difference.”). The registrations also show that the Office has recognized that ROMA has a suggestive significance as applied to food and restaurant services.

We find the term “Roma” is highly suggestive of Rome, Italy as used in connection with goods and services for Italian food such as pizza. Therefore, the dictionary evidence coupled with the third-party registration evidence does show conceptual weakness for the term ROMA, especially in connection with Italian restaurants and Italian food such as pizza.

In addition to the use evidence provided for the third-party registrations, Applicant submitted six additional third-party uses of “Roma” in connection with restaurants:

- Pizza Roma restaurant in New York City; the menu includes Italian classics and pizza. Applicant’s notice of reliance, 14 TTABVue 276.

- Roma’s Pizza restaurant in Grand Forks, ND, offering pizza as a menu item. Applicant’s notice of reliance, 14 TTABVUE 293.
- Roma Pizzeria and Restaurant, in Flint, MI, offering pizza as a menu item. Applicant’s notice of reliance, 14 TTABVUE 294.
- Roma Restaurant Craft Bar and Brewery in Wilnernie, MN, offering pizza as a menu item. Applicant’s notice of reliance, 14 TTABVUE 295.
- Roma Backdoor restaurant in Owosso, MI. Applicant’s notice of reliance, 14 TTABVUE 295.
- Roma’s Ristorante, (location unknown) offering pizza. Applicant’s notice of reliance, 14 TTABVUE 297.

As indicated, evidence of third-party use of similar marks on similar goods or services is relevant to show that a mark or a portion of a mark is relatively weak and entitled to only a narrow scope of protection because customers have been educated to distinguish the marks based on minute distinctions. *Palm Bay Imps.*, 73 USPQ2d at 1694.

Six of these uses for restaurant services show ROMA as the lead term, with five of these uses followed by a descriptive or generic term(s), while three of the uses for restaurant services show a descriptive or generic term preceded by the term ROMA. We find the use-based evidence coupled with the use evidence of the third-party registrations highly probative of commercial weakness of Opposer’s ROMA mark for “frozen pizza.” *Juice Generation*, 115 USPQ2d at 1674 (26 third-party marks used in connection with restaurant services or food products incorporating the three-word phrase “peace love” followed by a product identifying term (e.g., PEACE. LOVE. PASTA. and PEACE LOVE AND PIZZA) found probative of weakness); *Brooklyn Brewery Corp.* 2020 USPQ2d 10914, at *17 (six local Brooklyn-formative named

establishments' use of the term "Brooklyn" in connection with beer sales have significant probative value as to commercial weakness).

We find that Applicant's third-party use evidence is highly probative to demonstrate commercial weakness of the cited mark in the food industry.

This sixth *DuPont* factor favors a finding of no likelihood of confusion.

5. Similarity of the Marks

As to the first *DuPont* factor, "similarity or dissimilarity of the marks," we analyze "the marks in their entireties as to appearance, sound, connotation and commercial impression." *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) quoting *In re E.I. du Pont*, 177 USPQ at 567. See also *Palm Bay Imps.*, 73 USPQ2d at 1691 (quoting *In re E.I. du Pont*, 177 USPQ at 567). "The proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs.*, 101 USPQ2d at 1721 (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

In analyzing the similarity of the marks, we must consider them in their entireties. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). "In general, disclaimed or descriptive terms are considered less significant features

of the mark.” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)

Applicant’s mark is ROMA PIZZA and Opposer’s mark is ROMA.

The marks clearly share some similarity in sound, appearance, meaning and commercial impression in that they both include the highly suggestive term ROMA.

ROMA is the dominant term in Applicant’s mark due to the disclaimer of the term PIZZA. While the term PIZZA may be given less weight, it may not be ignored. *See M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) (“When comparing the similarity of marks, a disclaimed term, here ‘COMMUNICATIONS,’ may be given little weight, but it may not be ignored”). Therefore, we must evaluate whether ROMA PIZZA in its entirety is sufficiently similar to Opposer’s ROMA mark such that consumers would mistakenly believe the goods and services emanate from a common source.

When considered in their entirety, we find the marks are similar. However, in view of the conceptual weakness of the term ROMA, this *DuPont* factor only weighs slightly in favor of a finding of a likelihood of confusion.

6. Concurrent Use without Evidence of Confusion

The eighth *DuPont* factor considers “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. The Board recently held that the eighth *DuPont* factor “requires us to look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *6 (TTAB 2020).

Applicant argues that Applicant and Opposer's marks have co-existed for several decades and that this long co-existence without any consumer confusion should be weighed in its favor. Applicant's 18 TTABVUE 8, 10. Opposer, on the other hand, argues that there is no evidence of common consumers or consumer exposure to both marks in the actual marketplace. Opposer's brief 17 TTABVUE 14. Specifically, Opposer submits that "there is no specific evidence of record that the parties operate in the same city or metropolitan area or the volume of either parties' sales or exposure in such asserted overlapping areas" or that Opposer distributes ROMA pizza where Applicant is located. Opposer's brief 17 TTABVUE 14. Applicant argues that this overlap (opposer's use in the Upper Peninsula of Michigan and Applicant's use in Bangor, Michigan) is sufficient to show that the parties have co-existed. Applicant's brief 18 TTABVUE 8. However, we find that this evidence and testimony on its own is insufficient to show that the parties' goods and services have co-existed in the same geographic areas in Michigan.

The Bammann declaration provides limited evidence of actual market conditions. Mr. Bammann testified that he and his family have operated a restaurant in Bangor, Michigan since 1978. April 22, 2020 Bammann declaration ¶ 2, 14 TTABVUE 41; May 17, 2021 Bammann Declaration ¶¶ 1-4, 14 TTABVUE 299, and confidential exhibits, 15 TTABVUE. Mr. Bammann also testified that "at no point in time has any customer said or done anything suggesting that they thought my restaurant was associated with Opposer or its frozen pizzas" and that "customers throughout Michigan recognize ROMA PIZZA as a source indicator pointing to my restaurant."

April 22, 2020 Bammann declaration ¶¶ 4, 5, 14 TTABVUE 41. However, Mr. Bammann has not identified how long the parties' marks have co-existed and only identified the length of time he and his family have been in business. Nor has Mr. Bammann indicated the level of revenue for his services under the ROMA PIZZA mark to support his testimony that the mark is "well-known in Michigan."

Evidence of the extent and scope of Opposer's use of the ROMA marks in Michigan also is limited. Opposer's witness testified that its frozen pizzas are available in the "upper midwest" and that "Bernatello's has just recently entered the Michigan market with Menards distribution." Schultz declaration ¶¶ 11, 13, 17, 13 TTABVUE 231-234. Opposer's witness also testified that "[t]he ROMA products are currently on sale at supermarkets" in the United States including the following midwest states: Wisconsin, Minnesota, Iowa, Nebraska, U.P. of Michigan, Illinois, North Dakota, South Dakota, Missouri, Indiana, Kansas, Ohio. Schultz declaration paragraph ¶10, 13 TTABVUE 231-234. Opposer's testimony is corroborated by its website that states "Our Pizzas . . . are distributed through our DirectStoreDistribution system within the Midwest Region (WI, MN, IA, ND, SD, U.P. MI)" and that it is a "frozen pizza competitor in the Midwest." Applicant's notice of reliance, 14 TTABVUE 43-44. Opposer also submitted a map from the Internet, without witness testimony, to show that the upper portion of Michigan is far-removed from the lower portion, where Bangor, Michigan is located. This evidence is hearsay and cannot go to the truth of the matter, but shows on its face the distance between St. Ignace Michigan and Bangor Michigan. Opposer's notice of reliance, 13 TTABVUE 230.

While Opposer's witness testified that its products are available in Michigan and that it recently began selling pizza in the Upper Peninsula of Michigan, it did not provide any specific information as to the length of time its ROMA marks have been in use in Michigan. As to the scope of its use, the only testimony we have is that Opposer sells the ROMA pizza products in the Upper Peninsula of Michigan, and not other parts of Michigan.¹⁶

On this record, we cannot find that Applicant and Opposer have ever operated in the same area, which limits, if not eliminates entirely, the opportunity for confusion to occur. *See, e.g., Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1903 (Fed. Cir. 1989) (finding that the absence of evidence of actual confusion was of very little, if any, probative value because, among other reasons, "no evidence was presented as to the extent of [Applicant's] use of [its] mark on the merchandise in question during prior years"); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) ("instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks").

The eighth *DuPont* factor is neutral in our analysis of likelihood of confusion.

¹⁶ Applicant has also pointed to Opposer's prior statement in litigation involving a third party that it distributes its frozen pizza varieties to various grocery and convenience stores throughout the Midwest region, including Wisconsin, Minnesota, Iowa, North Dakota, South Dakota, and Michigan. But this statement is too general to establish that Applicant and Opposer operate in the same geographic areas in Michigan.

7. Variety of Goods on which a Mark is or is not used

As to the ninth *DuPont* factor, “the variety of goods on which a mark is or is not used,” *DuPont*, 177 USPQ at 567, Applicant argues that “the Cited Registrations narrowly identify one specific item, namely, ‘frozen pizza.’ This narrow scope ... distances the Cited Registrations from Applicant’s subject mark and identified services.” Applicant’s brief 18 TTABVUE 19. Because Opposer only uses its goods on frozen pizza, we find this *DuPont* factor neutral. *See e.g., DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *14 (TTAB 2020) (finding *DuPont* factor neutral because Opposer did not use the mark on a wide variety of goods).

VII. Conclusion

Opposer’s has not met its burden as to the non-use claim.

As to the Section 2(d) claim, we have balanced all of the evidence pertaining to the relevant *DuPont* factors and find that while the similarity of the marks, the relatedness of the goods and services and conditions of sale weigh in Opposer’s favor, the commercial weakness and the channels of trade weigh against a finding of likelihood of confusion.

In this case, the strength or weakness of the mark in the cited registration is the most important factor. *See In Re Hartz Hotel Svcs., Inc.* 102 USPQ2d 1150, 1155 (TTAB 2012) (finding the sixth *DuPont* factor dispositive) citing *Kellogg Co. v. Pack-Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.

... ‘each [of the thirteen elements] may from case to case play a dominant role.’’¹⁷ In view of the highly suggestive nature of ROMA in the food industry, and its commercial weakness, we find purchasers are able to distinguish among various ROMA marks by looking to other elements of the marks. In this case, that other element is the addition of the term PIZZA to Applicant’s mark rendering Opposer’s and Applicant’s marks sufficiently distinguishable that confusion is unlikely. *See In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) (“The record shows that a large number of marks embodying the words ‘bed and breakfast’ are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words ‘bed and breakfast.’”); *Murray Corporation of America v. Red Spot Paint and Varnish Co., Inc.*, 126 USPQ 390 (CCPA, 1960) (“EASY” and “EASYTINT” are not confusingly similar); *In Re Hartz Hotel Svcs., Inc.*, 102 USPQ2d at 1154 (because of the highly suggestive nature of the term “Grand Hotel,” the addition of a geographic term is sufficient to distinguish the marks); *In re Huncke & Jocheim*, 185 USPQ 188, 189 (TTAB 1975) (“...the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or

¹⁷ As stated above, we need not consider the issue of likelihood of confusion with respect to Opposer’s pleaded Registration Nos. 2315169 and 3817787 in view of our finding of no likelihood of confusion with respect to Registration No. 3839799. *See, e.g., See Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1243 (TTAB 2010).

possibly nothing more than a variant of the term, may be sufficient to distinguish between them so as to avoid confusion in trade.”).

Accordingly, we find that Applicant’s ROMA PIZZA mark is not likely to cause confusion with Opposer’s mark ROMA mark.

Decision: The nonuse claim and Section 2(d) claims are dismissed.